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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,793	02/11/2002	Darrel Cherry	10016811-1	7232

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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07/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/074,793

Applicant(s)

CHERRY ET AL.

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 7-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,4 and 7-14 is/are allowed.
- 6) ☒ Claim(s) 15-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Notice of Final Rejection

1.

The Declaration filed on June 11, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Japanese Publication NO. JP02001298779A.

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Japanese Publication NO. JP02001298779A reference.

37CFR 1.31(b) states in part:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

While the Declaration clearly evinced a period of conception prior to the effective data, Paragraph 3 of the Declaration alleges that Exhibit 1 demonstrates among others:

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A communication link;

Monitoring device;

A computer;

An interface between the computer and the communication link.

Upon closer view, Exhibit 1 consists of three pages. The first page is enumerated 1 of 3 and contains the internal identification of the invention (10016811). The second page is enumerated 2 of 3 which is presumed to be attached to the first page. The second page appears to be an account of a witness (Catherine Markle) and her acknowledgement that the alleged invention was explained on May 1, 2001.

The submission is denied for at least the reason:

It is uncertain if page 3 is related to internal docket (10016811).

The subject matter alleged in paragraph 3 of the Declaration is not commensurate with the text of paragraphs A and B of the last page of Exhibit 1.

There is insufficient information to link the inventors and the title of the invention with the last page of the Exhibit.

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2.

Art Rejection

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 15 and 16 are rejected under 35 U.S.C. 102(a) as being anticipated by Takahashi.

With respect to claim 15, Takashi teaches a system shown by figure 3, comprising a communication link (8); a computer (12) attached to the communication link (8); monitoring device via the data processing unit (4) which is attached to the communication link; an agent (system user) for providing an interface between the computer 12 and the link (8) where the agent receives an authorization code (authentication code), see lines 6-11 of the Solution and assigns the code with the terminal identification code of the terminal with the data which is to be printed; wherein the monitoring device (4) validates the authentication code, see Solution lines 9-11.

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With respect to claim 16, this limitation is inherent in that the monitoring device 4 contains a database (7) that stores the authentication codes for a plurality of terminal devices (client computers) which may be connected to the system of figure 3.

3.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Shen.

With respect to claim 17, Takahashi teaches all of the subject matter upon which the claims as set forth in the rejections of claims 15 and 16 above.

What Takahashi fails to teach is a monitoring device which prints data of a print job after authentication.

Shen teaches a system comprising a communication link (internet 12), a monitoring device (printer 30) attached to the link; an agent (server 14), a computer (equipment 1); wherein an agent receives an authorization code from the monitoring device.

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Moreover, Shen teaches the monitoring device permits printing of the print job by a printer if the authorization code is valid (see col. 6, lines 21- col. 7, line 31).

Since Takahashi and Shen are both directed toward systems of communication included authentication of data processing information, the purpose of using a monitoring device to authenticate and print a job would have been recognized by Takahashi as set forth by Shen.

It would have been obvious to one of ordinary skill in the art to modify the monitoring device (4) so that after the device 4 receives the print information and the authentication codes, a signal is sent to a print device instead of the service terminal as taught by Takahashi which validates, or allows a job to be transmitted by the device 4. Therefore, instead of sending a validation result to the service device, the validation data could be sent to a printer. Conversely, the service device may be modified to include a printing device connected thereto so that the validation data would then be sent to a printer from the monitoring device 4.

With respect to claims 20 and 21, Shen teaches the communication link comprises an Ethernet which is also a communication network, see figures 1 and 3 and col. 4, lines 18-31 and col. 6, lines 10-34.

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With respect to claim 22, Shen teaches the communication link is a switch in that it switches print jobs from various sources over a single network or over a single communication channel. This limitation is also inherent in the function of basic communication networks.

With respect to claim 23, Takahashi teaches that the monitoring device contains server like functions (via member 4 of figure 3).

With respect to claim 24, Shen teaches that authentication code is embedded in a header of a print job (see col. 5, lines 5-35).

With respect to claim 25, Shen teaches that the authorization code is part of an HTTP communication related to the print job (see col. 4, lines 14-31).

The motivation for the rejection of claims 20-25 is the same as that as to claim 17 above.

4.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Shen in further view of Gecht.

Takahashi in view of Shen, in combination, teaches all of the subject matter upon which the claim depends.

What is not specifically taught by Takahashi and Shen in the external interval parameter and the quality of service parameter.

Gecht teaches sending a print job with the authorization code to the remote monitoring device(col. 11, lines 16-60), the remote monitoring device checking whether the authorization codes is valid (col. 10, line 60 – col. 11, line 50); enabling printing of the print job upon determining that the authorization code is valid (col. Line 11, lines 2-24), and disabling printing of the print job upon determining that the authorization codes is invalid. Gecht teaches that the authorization codes comprises an expiration parameter which is also a quality of service parameter, according to col. 8, lines 35-65 and col. 11, lines 42-50.

Takahashi, Shen and Gecht are combinable because they are from the same field of image transmission systems over a communication link that utilize authentication or verification procedures.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the use of the quality service parameter, as taught by Gecht, with the device 4 of Takahashi, taught in combination with Shen, for the purpose of providing a user with an ability to measure system integrity when obtaining a print job as suggested by Gecht.

5.

Claims Allowed

Claims 1, 3, 4, and 7 are allowed for the reason the prior art does not teach in claimed combination, "...subsequently sending the print job with the authorization code from the client computer to the remote monitoring device... the remote monitoring device checking whether the authorization code is valid... disabling printing of the print job by a printer remote from the remote monitoring device upon determining that the authorization code is valid."

Claims 8-14 are allowed for the reason the prior art does not teach or suggest in claimed combination, "...sending an authorization code from a host located on the communications link to a client computer located on the communications link... embedding the authorization code in a header of a print job... checking whether the authorization code is valid prior to enabling or disabling the print job from printing."

6.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

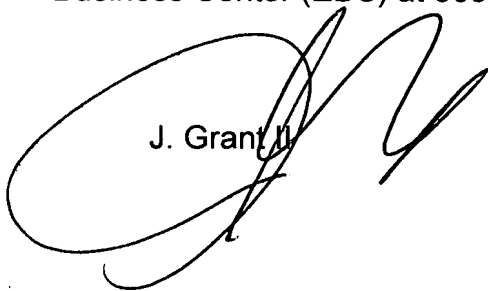
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


J. Grant II